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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,984	12/05/2000	Yisroel Lefkowitz	600474-003	8696
61834 7590 05/20/2009 Ostrow Kaufman & Frankl LLP Susan Formicola The Chrysler Building 405 Lexington Avenue, 62nd Floor NEW YORK, NY 10174				
EXAMINER				
ALVAREZ, RAQUEL				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
05/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/729,984

Applicant(s)

LEFKOWITZ, YISROEL

Examiner

Raquel Alvarez

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12,14-20,85,96-102,104,105 and 108 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1,2,4-12,14-20,85,96-102,104,105 and 108 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to communication filed on 3/9/2009.
2. Claims 1-2, 4-12, 14-20, 85, 96-102, 104-105 and 108 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-2, 4-5, 7-12, 14, 15, 17-19, 85, 85, 96-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (6,847,965 hereinafter Walker) in view of Business Wire "Air France Corrects and Replaces Previous Announcement", hereinafter Air France.**

Walker teaches offering to sell to a customer at least one specific item at an offering price (i.e. using input device 306, the customer remotely order a first item from a merchant)(see figure 1);

in conjunction with said offer to sell said specific first item at said offering requiring said customer to select as part of a single transaction at least one second item to be selected from a group of one or more second items, said offer to sell said second item and said offer of at least one second item being made over a computer network

from a single merchant (i.e. as part of the order of the first item, the customer is required to select from a plurality of complementary items that he is entitled to receive free of charge for making the purchase of the first item. The complimentary item is added to the single transaction free of charge)(Figure 3, 328 and col. 13, lines 47-54);

said merchant acknowledging said customer decision to purchase said at least one specific first item and said at least second item, the acknowledgment being made over said computer network (see figure 1);

said merchant accepting payment over said computer network from said customer for said first item (figure 15B, step 1566);

said merchant delivering the first item to said customer (figure 16A, step 1604);

said merchant advising said customer of the method of delivery of said at least second item to said customer, said method of delivery being connected to said customer engaging in the first item (i.e. the customer is delivered both ordered items at step 1604).

With respect to the first item being an international travel ticket and the second item being a duty free item. Air France teaches customer purchasing an international ticket being offered discounts for duty free items. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the invention of Walker international tickets and duty free items in order to motivate customer to buy international flights.

With respect to all or a portion of the concession fee normally charged to merchants for selling or delivering duty free items is not charged, the price of the travel

ticket, the duty free item or the combination of both is accordingly reduced or discounted and that the duty free items are delivered at or near an exit point or on board a passenger carrier for which the international travel ticket is sold. Official Notice is taken that it is old and well known for merchants and the like to negotiate an agreement with a manufacturer, host, provider of a goods and services and to pass all or some of the savings that result from said agreement to the customers. For example, Costco® is a wholesaler corporation which buys in bulk at a discount and passes some of the savings to their members. It would have been obvious in the combination of Walker and Air France to have included the teachings of the well known business method of passing on some or all the savings negotiated to the customers in order to provide the customer with discount and hopefully increase sale. With respect to delivering the duty free items at or near an exit point, the Examiner wants to point out that delivering the duty free items near the exit is the norm at airports in order to assure that duty free merchandises are consume outside the country which sold the items. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included delivering and locating the duty free shops near an exit point as being done by major airports in order to obtain the above mentioned advantage.

5. Claims 6, 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Air France further in view of Ong-Yeoh "Golden Boutique Set to Boost MAS Revenue", hereinafter Ong-Yeoh .

Ong-Yeoh teaches advising the customer that the duty free items will be

delivered to the customer at one of an international port of departure ("pre-order business where passengers can purchase their tickets and duty free items to be delivered at the airport). It would have been obvious to one having ordinary skill in the art at the time of the invention to have advised the customer of item delivery as in Ong-Yeoh in the system of Walker since the item delivery would have been adopted for the intended use of the pre-order business of Walker at least where the ticket and item inspection verifies eligibility of the duty free item.

Response to Arguments

6. The Examiner wants to point out that various interviews have been granted on this application.
7. Applicant states that on 6/30/2008, amendments were filed and that the Examiner improperly relied on "Official Notice" to reject the claims. The Examiner wants to point out that the Examiner properly rejected the claims using example of well known facts to support the rejection under 103 and including motivation statements and therefore the rejections are proper.
8. Applicant states that the Examiner didn't address the arguments presented on 6/30/2008. The Examiner wants to point out that the arguments were moot because Applicant was mainly arguing the newly amended feature presented on the amendment filed on 6/30/2008 and the amendment led to new well known statements (Official

Notice) and that's the reason why the Examiner didn't address the arguments because it was pertaining to newly amended features.

9. Applicant argues that Walker "buy one get one free" fails to teach or suggest a specific pricing determination for one or both items based on the savings of all or portion of a concession fee charged by the passenger carrier for the sale and delivery of a duty free item. The Examiner wants to point out that Official Notice was taken with respect to this item (see above rejection) and therefore it should be argued accordingly.

10. With respect to Applicant's arguments pertaining to "offering to sell....a specific international travel ticket....and one or more specific duty free items", Applicant states that there's no teaching of Air France for the sale of a duty free item. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Walker was cited to teach the customer under one single transaction buying an item and receiving a complimentary item. Air France was merely cited to teach duty free items and therefore the combination of Walker and Air France teach under one single purchase transaction offering a discounted price of a second item (Walker teaches the customer buying an item and receiving the second item for free or at discount price of zero) Walker doesn't teach the second item being duty free items and Air France teaches the purchase of

international tickets tie in to duty free items therefore it would have been obvious to have included in the system of Walker to replace the items of Walker with Air France international tickets and duty free items in order to motivate purchases in the airline industry.

11. With respect to the official Notice taken pertaining to "said merchant having arranged with the first passenger carrier for delivery of the at least one specific duty free item to said customer during the travel associated with said specific international travel ticket without the merchant being required to pay at least a portion of a concession fee otherwise charged by the first passenger carrier to merchants for selling or delivering such duty free items" the example given by the Examiner of Costco ® being a wholesaler and having an agreement with the customer to sell the goods for a discounted price shows the basic notion of entering into agreements with merchants/vendors and the like and for merchants/vendors and the like to pass the savings on to their customers.

12. Furthermore, Applicant argues the Official Notice taken is improper because the Official Notice does not totally address, "said merchant having arranged with the first passenger carrier for delivery of...the duty free item to said consumer...without the merchant required to pay at a portion of a concession fee "The Examiner had taken Official Notice that it is old and well known in general to enter into agreements between the parties involved in order to reduce cost. Applicant interprets "agreement" as used

by the Examiner solely to mean the notion of bulk sales and passing savings to customers but the Examiner does not use the Official Notice in this limited context. Rather, the Examiner makes a general statement as to the known practice of making an agreement between two parties in order to pass on the savings and reducing cost. Nothing in this known practice of not charging a fee to or reducing cost based on a prior agreement between the parties prohibits it from being applied to merchants having an arrangement with a first passenger carrier for delivery and reducing cost/fee of the delivery of duty free items.

13. Applicant argues that Air France fails to teach or suggest delivery of the duty free item to said customer during travel associated with said specific international travel ticket. The Examiner wants to point out that Walker was the reference cited to teach the customer under one single transaction buying an item and receiving a complimentary item. Air France was merely cited to teach combining international tickets with receiving a discount for duty free items and therefore the combination of Walker and Air France teach under one single purchase transaction offering a discounted price of a second item (Walker teaches the customer buying an item and receiving the second item for free or at discount price of zero) Walker doesn't teach the second item being duty free items and Air France teaches the purchase of international tickets tie in to duty free items therefore it would have been obvious to have included in the system of Walker to replace the items of Walker with Air France international tickets and duty free items in order to motivate purchases in the airline industry.

14. With respect to Applicant's arguments pertaining to the official notice taken that delivering of duty free items at or near exit points at airports is well known and the use of "nowadays" doesn't predate the filing date of December 2000. The Examiner wants to point out that the use of "nowadays" is a typo and therefore should be omitted from the rejection. The Examiner wants to point out that duty free shops have been placed near the exit of the airports way before Applicant's filing date of December 2000. The Examiner is citing Patent number 6,102,331 issued to Hong, priority filing date October 1996 pertains to operation of airports and it teaches on col. 1, lines 40-43 "a departure lounge which may include a duty-free shopping area. As can be seen by the above reference delivering of duty free items near exit or departure is well known prior to Applicant's filing date of December 2000.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James w. Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

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5/19/2009

/R. A./